

**Remarks**

This is a complete response to the Office Action mailed March 1, 2006. The amendments and remarks are proper, do not introduce new matter, are not narrowing in view of a rejection over a cited reference, and place the application in proper condition for reconsideration and withdrawal of the restriction requirements and the rejections.

Absent the requested reconsideration, these remarks also explain why this case is not in condition for appeal.

The amendment to claim 30 is made solely in order to more particularly point out and distinctly claim the patentable subject matter of the present embodiments. This amendment does not change the scope of the claimed subject matter, and it is still properly construed in accordance with 35 USC 112 paragraph six.

**Restriction Requirement**

Applicant acknowledges the Examiner's lengthy discussion of the restriction requirement. However, rather than responding to Applicant's argument that the Examiner has failed to substantiate an evidentiary basis for the restriction, the discussion spanning 1½ pages just asserts that the evidentiary basis has been made, without pointing out how.

Applicant again reiterates that the restriction between groups I and II claims is not substantiated because the Examiner has not shown either how the process of claim 1 can be used to make a materially different product, or how the product of claim 25 can be made by a materially different process. (MPEP 806.05(f)) Applicant has rebutted the Examiner's assertion that the product of claim 25 can be aligned by shear forces rather than rotation, by pointing out that rotation is a (rotary) shear force. Applicant has also rebutted the Examiner's assertion that

the biasing step of claim 1 doesn't require rotation, by pointing out that the placing step of claim 1 does. In both instances Applicant's position remains that no materially different process or product made has been substantiated. Ultimately, the Examiner appears to be confusing the requisite evidentiary requirements for substantiating a restriction requirement with patentability issues of a method claim.

Applicant also again reiterates that the restriction requirement between groups I and III claims and between groups II and III claims is likewise not substantiated because the Examiner has failed to show how the process of claim 1 can be used to make a materially different product, or how the products of claim 25 and 30 can be made by a materially different process. (MPEP 806.05(f)) Applicant has rebutted the Examiner's assertion that claim 30 requires "servo information on the motor" (Examiner argued not required by claims 1 and 25) by amending it to recite *servo information [[on]] onto the motor....* Curiously, in the latest discussion the Examiner appears to conclude that the restriction requirement is substantiated simply on the basis that some are product claims and some are process claims.

In any event, Applicant again requests reconsideration and withdrawal of the restriction requirement because the Examiner has not substantiated it according to MPEP 806.05(f).

### **Rejection Under Section 102**

Claims 1, 3, 5, 7, 9, and 21 stand rejected as being anticipated by Kuroba '990. This rejection is traversed again.

Applicant again reiterates that Kuroba '990 cannot sustain a Section 102 rejection because it fails to identically disclose *placing prewritten discs, each characterized by servo tracks that are offset in relation to a common angular reference axis of each disc, around a*

*motor hub, the prewritten discs placed with respect to each other disposing the angular reference axes symmetrically around the motor hub....* (see Applicant's Response of 11/22/2005, ppg. 17-18; Applicant's Response of 1/31/2005, ppg. 14-16; Applicant's Response of 11/30/2004, ppg. 13-15)

Despite Applicant having argued the merits of the patentability of claim 1 over Kuroba '990 three times now, the Examiner again rejects the claim on the basis of mischaracterizing Kuroba '990. Particularly, the Examiner states:

The "common angular reference axis" for each disc can be read as any axis along each disc used in biasing or balancing the disc as the servo tracks will be offset in relation to this "common angular reference axis."  
(Office Action of 3/1/2006, pg. 4)

Applicant hopes a simple illustration can make the Examiner, or a Pre-Appeal Brief Panel, understand that this statement is absolutely wrong. Applicant has argued previously that the *angular reference axis* can in some embodiments be aligned with an existing reference on each disc, such as a timing mark. Thus, if the claim 1 phrase *angular reference axis* is replaced with the phrase "timing mark," then claim 1 would read as follows:

A method comprising:

placing prewritten discs, each characterized by servo tracks that are offset in relation to a common **timing mark** of each disc, around a motor hub, the prewritten discs placed with respect to each other disposing the **timing marks** symmetrically around the motor hub; and

biasing each disc in a direction of the respective **timing mark** to concentrically align the servo tracks of a first disc of the prewritten discs with the servo tracks of a second disc of the prewritten discs.

Accordingly, it is clear from the plain language of the claim that the “common timing mark” is relevant only to the offset of the servo tracks, and not relevant to the biasing direction as argued by the Examiner.

A “common timing mark” of each disc plainly means the same mark on each disc, such as the zero degree timing mark of each disc. In that case, the servo track offset of each disc is in relation to the zero degree timing mark. As Applicant has argued, that makes each of the discs identical, as opposed to Kuroba ‘990 which explicitly discloses that each group of discs that have different contact points must have the servo track writing performed separately (see, for example, Applicant’s Response of 11/22/2005, pg. 18 citing Kuroba ‘990 col. 8 lines 31-41). The skilled artisan readily recognizes the reason the groups are written separately is because the servo track offsets are in relation to different timing marks, not a common timing mark as in the present embodiments.

Applicant sincerely hopes this illustrative example is helpful in showing that the language of claim 1 plainly requires that the common timing marks (angular references) of discs forming a stack must be rotationally aligned during servo track writing, and then must be rotationally misaligned during biasing. This example, wherein the angular references are analogized to timing marks, is not in any way limiting of the contemplated scope of the present embodiments.

Applicant again reiterates that the Examiner has failed to substantiate a prima facie case of anticipation because Kuroba ‘990 does not identically disclose all the recited features of claim

1. Reconsideration and withdrawal of the rejection of claim 1 and the claims depending therefrom are respectfully requested.

Absent the requested reconsideration, a Pre-Appeal Brief Panel must find in the underlying facts “substantial evidence” that adequately supports the Examiner’s legal conclusion

of anticipation. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Only a travesty in equities would require Applicant to proceed to appeal on a rejection based on mischaracterizations of what is claimed and what the cited reference discloses. Accordingly, this case is not in condition for appeal due to the unresolved factual issues that the Examiner has failed to make the requisite evidentiary showing in the record substantiating a prima facie case of anticipation, and due to the factual mischaracterizations of the cited reference, and due to the legal mischaracterizations asserted in the flawed attempt at a prima facie case of anticipation.

#### **Rejection Under Section 103**

Claims 6 and 8 stand rejected as being unpatentable over Kuroba '990 and over Kuroba '990 in view of JP '442, respectively. These rejections are traversed because these claims are allowable as depending from an allowable independent claim, for reasons above, and providing additional limitations thereto. Reconsideration and withdrawal of the present rejection of these claims are respectfully requested.

#### **Allowable Subject Matter**

Applicant gratefully acknowledges the indication of allowability of claims 22-24. However, Applicant has opted not to place these claims in independent form because the independent claims from which they depend are allowable, for reasons above. These claims are

therefore allowable as depending from an allowable independent claim and providing additional limitations thereto.

**Conclusion**

This is a complete response to the Office Action mailed March 1, 2006. The Applicant has also filed herewith a Request for Telephone Interview with the Examiner and his supervisor at a time before the Examiner makes any action on the merits other than passage of all claims to issuance. The interview is necessary to clarify disputed issues where the incompleteness of this latest Office Action, the RCE requirement, and the finality of the restriction requirement have unduly delayed the issuance of Applicant's valuable patent rights.

The Examiner is invited to contact the below signed Attorney should any questions arise concerning this response or the request for interview.

Respectfully submitted,

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